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In re Application of :
Puttkammer et al. :
Application No. 08/894,766 : ON PETITION
Filed: August 30, 1997 :
Attorney Docket No. 970224 :

This is a decision on the petition filed March 13, 2000 which is being treated as a request under (1) 37 CFR 1.181 (no fee), for withdrawal of the holding of abandonment, or, alternately, (2) under 37 CFR § 1.137(a), revival of the above-captioned application.

The petition under 37 CFR 1.181 is dismissed.

The petition under 37 CFR 1.137(a) is dismissed.

A final Office action was mailed to the correspondence address of record on August 2, 1999 which set a non-extendible statutory period of three (3) months for reply. As the reply was not submitted on or before the due date, and no extension of time were obtained this application became abandoned by operation of law (35 USC § 133) on November 2, 1999. A Notice of Abandonment was mailed March 1, 2000.

The instant petition was filed March 13, 2000. Petitioner asserts that the Office action was not received, and as such, the delay was unavoidable. See MPEP 711.03(c) for treatment of petitions to revive containing allegations of non-receipt of an Office action

1. Petition to Withdraw the Holding of Abandonment:

As the petition asserts non-receipt of a PTO communication, the petition is properly also considered as a request to withdraw the holding of abandonment. See MPEP 711.03(c) § I. Initially, there is no dispute that the reply was not submitted within the period required by the outstanding

Office action of August 2, 1999. Therefore, this application is properly considered abandoned by operation of law (35 USC § 133). It is petitioner's burden to demonstrate, that counsel did not receive the aforementioned office action, for a withdrawal of the holding of abandonment to be warranted.

A review of the written record indicates no irregularity in the mailing of Office action of August 2, 1999, and in the absence of any irregularity there is a strong presumption that the action was properly mailed to former counsel at the address then of record. This presumption may be overcome by a showing that the Notices were not in fact received. The showing required to establish the failure to receive an Office communication must consist of:

> (1) a first-hand statement from the practitioner stating that the Notice was not received by the practitioner,
> (2) his attestation to the fact that a search of the file jacket and docket records indicates that the Notice was not received, and
> (3) a copy of the docket record where the non-received Notice would have been entered had it been received and docketed must be attached to and referenced in the practitioners' statement. See MPEP 711.03(c)§ I; 1156 *O.G.* 53 (November 16, 1993).

The showing of current counsel has been considered, but the showing lacks items (2), (3) above. Accordingly, the holding of abandonment has not been overcome and will not be withdrawn. See MPEP 711.03(c), § I.

(2) With respect to the petition considered under 37 CFR 1.137(a):

A grantable petition to revive an abandoned application under 37 CFR 1.137(a) must be accompanied by (1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof; (2) the petition fees set forth in § 1.17(l); and (3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable. This petition lacks items (1) and (3).

As to item (1), no reply has been received. As requested by applicants, a copy of the Office action in question is enclosed with this decision.

As to item (3), petitioner asserts that the delay was caused by nonreceipt of the Office action of August 2, 1999 by counsel.

The showing of record is inadequate to establish unavoidable delay within the meaning of 37 CFR 1.137(a).

The decision of the PTO on the question of whether the delay herein was unavoidable *vel non* can only be based on the contents of the administrative record in this case. See, Douglas v. Manbeck, 21 USPQ2d 1697, 1699-1700 (E.D. Pa. 1991), *aff'd*, 975 F.2d 869, 24 USPQ2d 1318 (Fed. Cir. 1992); Haines v. Quigg, supra. As noted above, since the showing of record lacks adequate documentary proof that the Office action of August 2, 1999 was not received by counsel, the delay has not been adequately shown to have been unavoidable.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents
Box DAC
Washington, D.C. 20231

By FAX: (703) 308-6916
Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23
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Telephone inquiries related to this decision should be directed to the undersigned at (703) 305-1820.

Brian Hearn

Brian Hearn
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

Enclosure: Office Action of August 2, 1999